REMARKS

This is a full and timely response to the outstanding Office Action mailed July 22, 2004. Upon entry of the amendments in this response, claims 1, 2, 4-21, and 23-29 are pending. More specifically, claims 1, 18, and 21 are amended, and claims 3 and 22 are canceled. Canceled claims 3 and 22 have been added to their independent base claims. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claims 1-28 are rejected under 35 U.S.C. §103 as being unpatentable over Melet *et al.* (U.S. Patent No. 6,615,238 B1) in view of Nevarez *et al.* (U.S. Patent No. 6,189,103 B1). Claims 1-28 are rejected under 35 U.S.C. §103 as being unpatentable over Bliss *et al.* (U.S. Patent No. 6,654,789 B1) in view of Glenn *et al.* (U.S. Patent No. 5,907,677).

II. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Vu spent with Applicant's Attorneys Jeff Kuester and Benjamin Balser during an August 19, 2004 telephone discussion regarding the above-identified Office Action. Applicant believes that issues identified during the telephone discussion are resolved herein, including clarification of extracting a domain name or email address from an incoming email communication, which is not disclosed in *Melet* or *Nevarez*. During that conversation, Examiner Vu seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Vu carefully consider this amendment and response.

III. Rejections Under 35 U.S.C. §103(a)

A. Claims 1-28 and *Melet* in view of *Nevarez*

The Office Action rejects claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over Melet *et al.* (U.S. Patent No. 6,615,238) in view of Nevarez *et al.* (U.S. Patent No. 6,189,103 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

creating a list of domain names in a memory;

receiving an incoming email communication;

extracting a domain name from a sender's email address from the incoming email communication;

storing the domain name in the list of domain names in the memory;

checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the list of domain names in the memory; and

generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication if the domain name is not included in the list of domain names.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Melet,* in view of *Nevarez,* does not disclose, teach, or suggest at least **extracting a domain name from a sender's email address from an incoming email**. The

Office Action submits that this claim language is disclosed in *Melet*, col. 7, lines 4-17. *See* Office Action, Page 4, Paragraph 7.

Melet, col. 7, lines 4-17 read:

> Table 1 below lists some exemplary categories, however the list is not inclusive and many other categories are possible. The categories displayed to the user in the pull-down menu may be a subset of a larger set of categories available from the remote interrogation processing system 530. In that case, the subset of categories presented to the user may be selected by a provider of the host Web page and the evolving interactive dialog box may obtain the selected subset according to a URL or hostID value embedded in the host Web page. Also, the categories menu may include text having an embedded hyperlink to a Web page for the remote interrogation processing system 530. Further details regarding categories will be explained below with respect to FIG. 7.

Applicant respectfully submits that this assertion made in the Office Action lacks merit. There is no mention of extracting a domain name from a sender's email address from incoming email communications.

The Office Action also submits that this claim language is disclosed in *Melet*, col. 8, lines 30-40; col. 11, lines 37-49; and col. 12, lines 37-50. *See* Office Action, page 5, paragraph 12.

Melet, col. 8, lines 30-40 read:

> In a further embodiment, the second revolution may include a reply method pull-down menu listing various acceptable optional methods by which the Internet user may receive a reply. For example, options may include e-mail message, facsimile, "snail mail," telephone, Fed Ex, instant chat, overnight mail, interactive video, interactive audio, or other similar methods. In that case, the Internet user selects a desired reply method from the pull-down menu and enters an appropriate destination (e.g., e-mail address; facsimile number; postal address; etc.) into the data entry box.

Melet, col. 11, lines 37-49 read:

> If the CurrentPage value is 1 or 3 in the step 670, then the Applet proceeds to the step 690. A CurrentPage value of 1 indicates that the second revolution is being displayed, and that the user has completed entering his or her destination (e.g., e-mail) address and has made an opt-in/opt-out selection. In that case, in the step 690, the Applet sends an Http request via the Internet to a remote interrogation processing system, passing a categoryID value, a userID value, a sponsorID value, an opt-in/opt-out value, an e-mail

> address, and a question (preferably as a text stream) from data entered by the use in the first and second revolutions of the evolving interactive dialog box.

Melet, col. 12, lines 37-50 read:

> In a step 720, an Internet user specifies a destination e-mail address where the user desires to receive a response to his or her question, and makes an Opt-in/Opt-out selection. Preferably, the user enters the destination e-mail address and indicates the Opt-in/Opt-out selection via an evolving interactive dialog box. Alternatively, the user may enter the destination e-mail address and the Opt-in/Opt-out selection through a normal dialog box appearing on a home Web page of a company hosting or providing the interrogation answering service. The destination e-mail address and the Opt-in/Opt-out selection is communicated, preferably over the Internet, to a remote interrogation processing system.

Applicant respectfully submits that this assertion made in the Office Action lacks merit. There is no mention of extracting a domain name from a sender's email address from incoming email communications. The email address in this section of *Melet* is entered by an internet user into a dialog box on a web page. It is not the sender's email address extracted from incoming email communications. It is a destination email address.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Notwithstanding, no such teaching can be found anywhere within these references. Therefore, the rejection should be withdrawn.

Likewise, the rejections to independent claims 8, 18, 21, and 26 should be withdrawn for similar reasons. Claim 8 recites **extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server**. Claim 18 recites an **interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications**. Claim 21 recites **storing, in the list of e-mail addresses in the memory, an email address extracted from the incoming email communications**. Claim 26 recites **an address extractor for extracting senders' e-mail addresses from incoming e-mail communications**. Each of these independent claims recites extracting either a domain name or an email address from an *incoming* email communication. Therefore, similar arguments apply to these claims as apply to claim 1 hereinabove. As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or

explicitly, all the elements of these independent claims. Notwithstanding, no such teaching can be found anywhere within these references. Therefore, the rejections should be withdrawn.

Nonetheless, each claim does have different combinations of elements and should be analyzed separately if any further search is deemed necessary. Additionally and notwithstanding the analysis hereinabove, there are other reasons why the independent claims are allowable.

Because the independent claims are allowable over the prior art of record, the dependent claims (which depend from the independent claims) are allowable as a matter of law for at least the reason that the dependent claims contain all the steps/features of the independent claims. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to the dependent claims should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of the independent claims, the dependent claims recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why the dependent claims are allowable.

B. Claims 1-28 and *Bliss* in view of *Glenn*

The Office Action rejects claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over Bliss *et al.* (U.S. Patent No. 6,654,789) in view of Glenn *et al.* (U.S. Patent No. 5,907,677). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

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extracting a domain name from a sender's email address from the incoming email communication;

storing the domain name in the list of domain names in the memory;

checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the list of domain names in the memory; and

generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication if the domain name is not included in the list of domain names.

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Glenn, col. 1, lines 22-30 read:

> Domain names direct where e-mail is sent, files are found, and computer resources are located. They are used when accessing information on the WWW or connecting to other computers through Telenet. Internet users enter the domain name, which is automatically converted to the Internet Protocol address by the Domain Name System (DNS). The DNS is a service provided by TCP/IP that translates the symbolic name into an IP address by looking up the domain name in a database.

Applicant respectfully submits that this assertion made in the Office Action lacks merit. There is no mention of extracting a domain name from a sender's email address from incoming email communications.

The Office Action also submits that this claim language is disclosed in *Melet*, col. 5, lines 24-39. *See* Office Action, page 14, paragraph 40.

Bliss, col. 5, lines 24-39 read:

> As a further feature, if the preferred address is not known by the system, a heuristic table is consulted. This table contains a list of unrecognized queries and the likely corrections. The table is generated by creating a list of common misspellings to commonly used domain names or changes to commonly used domain names. For example, if it is determined that a common misspelling of the domain name freshaddress.com is freshadress.com, then the table will refer to freshaddress.com for all appearances of freshadress.com. Similarly, if the provider of freshaddress.com changes all e-mail addresses to freshaddressinc.com, then the table would match those two addresses. If an entry is found in the table, the visitor is notified of his possible error and the suggested correction. The system may then prompt the visitor to perform a corrected query.

Applicant respectfully submits that this assertion made in the Office Action lacks merit. There is no mention of extracting a domain name from a sender's email address from incoming email communications. The email address in this section of *Bliss* is entered by an internet user into a dialog box on a web page. It is not the sender's email address extracted from incoming email communications. It is a destination email address. Additionally it could be any email address; it is not limited to the email address of the sender of an email communication.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Notwithstanding, no such teaching can be found anywhere within these references. Therefore, the rejection should be withdrawn.

Likewise, the rejections to independent claims 8, 18, 21, and 26 should be withdrawn for similar reasons. Claim 8 recites **extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server**. Claim 18 recites an **interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications**. Claim 21 recites **storing, in the list of e-mail addresses in the memory, an email address extracted from the incoming email communications**. Claim 26 recites **an address extractor for extracting senders' e-mail addresses from incoming e-mail communications**. Each of these independent claims recites extracting either a domain name or an email address from an *incoming* email communication. Therefore, similar arguments apply to these claims as apply to claim 1 hereinabove. As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or

explicitly, all the elements of these independent claims. Notwithstanding, no such teaching can be found anywhere within these references. Therefore, the rejections should be withdrawn.

Nonetheless, each claim does have different combinations of elements and should be analyzed if any further search is deemed necessary. Additionally and notwithstanding the analysis hereinabove, there are other reasons why the independent claims are allowable.

Because the independent claims are allowable over the prior art of record, the dependent claims (which depend from the independent claims) are allowable as a matter of law for at least the reason that the dependent claims contain all the steps/features of the independent claims. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to the dependent claims should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of the independent claims, the dependent claims recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why the dependent claims are allowable.

IV. Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-29 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

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